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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,795	03/27/2001	Shinichiro Suzuki	JP920000086US1	9880

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EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/818,795	<b>Applicant(s)</b> SUZUKI, SHINICHIRO	
	<b>Examiner</b> Zachary A Davis	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) *   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20020805</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. It is noted, however, that applicant has not filed a translation of a certified copy of the Japanese 2000-098818 application as required by 35 U.S.C. 119(b).

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 225 (see Figure 5). Further, the drawings are objected to because in Figure 5, although it is clear that after step 235 the user is notified of the illegal use of the terminal, it is unclear as to what action is performed after step 225 has completed. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the

page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 12 is objected to because of the following informalities: The claim recites the limitation of sending information and a password "to external" in line 22 on page 33, and receiving the information and password "from external" in line 1 on page 34. These limitations would read more clearly if changed to "to an external device" and "from an external device" or similar. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8, 13, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "said communication terminal" in line 11 on page 32. It is unclear whether this refers to the first or the second communication terminal, which

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renders the claim indefinite. For purposes of applying the prior art, this is assumed to refer to the second communication terminal.

Claim 13 recites the limitation that the terminal "can also include a removable storage medium that can store said identification information and said password". The use of the phrase "can also include" renders the claim indefinite because it is unclear whether the limitation following the phrase is part of the claimed invention. Further, the use of the phrase "can store" renders the claim indefinite because it is unclear whether or not the claimed element is, in fact, performing the recited function.

Claims 20 and 21 are directed to "A computer program product as recited in Claim B1". It is not clear from which claim(s) these claims are intended to depend. This renders the claims indefinite. For purposes of applying the prior art, it is assumed that Claim 20 is intended to correspond substantially to the terminal of Claim 10 and that Claim 21 is intended to correspond substantially to the apparatus of Claim 14.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Yu et al, US Patent 6067621.

In reference to Claim 1, Yu discloses a method for communicating with a network from a terminal that includes sending identification information and a password stored in nonvolatile memory to a network at a start of a communication (column 9, lines 31-34), generating another password that is different from the sent password (column 10, lines 43-59), storing the generated password in the nonvolatile memory (column 10, lines 59-61), and sending the generated password to the network (column 9, lines 31-34).

In reference to Claim 2, Yu further discloses that the generated password is sent at the end of the communication (column 10, lines 64-66).

In reference to Claim 9, Yu further discloses that the password is generated at random (column 6, lines 47-60, where the password generation includes encrypting a random number).

In reference to Claim 3, Yu discloses a method for communicating with a network from a terminal that includes receiving identification information and a password stored in nonvolatile memory (column 10, lines 64-66), comparing the received identification information and password with identification information and a password stored in the storage of the network (column 11, lines 7-10), enabling the terminal to communicate with the network in response to the result of the comparison (column 11, lines 10-11), receiving another password that is different from the first received password, and storing that second received password in the storage (column 11, lines 24-29).

In reference to Claim 4, Yu further discloses stopping communication in the event that the second received password corresponds to the first received password (column 11, lines 39-43).

In reference to Claim 5, Yu further discloses that the second password is received at the end of the communication (column 10, lines 64-66).

In reference to Claim 6, Yu discloses a method for communicating with a network from a terminal that includes sending identification information and a password to the network (column 9, lines 31-34), comparing the sent identification information and password with identification information and a password stored in the storage of the network (column 11, lines 7-10), enabling the terminal to communicate with the network in response to the result of the comparison (column 11, lines 10-11), generating another password that is different from the sent password (column 10, lines 43-59), storing the generated password in the nonvolatile memory of the terminal (column 10, lines 59-61), sending the generated password to the network (column 9, lines 31-34), and storing the second sent password in the storage (column 11, lines 24-29).

In reference to Claim 7, Yu discloses a method for communicating with a network using two terminals, where the method includes storing identification information and a password, which were stored in a first nonvolatile memory, in a second nonvolatile memory (column 6, lines 42-45); inhibiting the use of the first terminal (column 6, lines 45-46, where the random number is deleted); sending the identification information and

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password from the second terminal to the network (column 9, lines 31-34); generating another password that is different from the sent password (column 10, lines 43-59); storing the generated password in the nonvolatile memory of the second terminal (column 10, lines 59-61); and sending the generated password to the network (column 9, lines 31-34).

In reference to Claim 8, Yu discloses a method for communicating with a network using two terminals, where the method includes storing identification information and a password, which were stored in a first nonvolatile memory, in a second nonvolatile memory (column 6, lines 42-45); inhibiting the use of the first terminal (column 6, lines 45-46, where the random number is deleted); sending the identification information and password from the second terminal to the network (column 9, lines 31-34); comparing the received identification information and password with identification information and a password stored in the storage of the network (column 11, lines 7-10); enabling the second terminal to communicate with the network in response to the result of the comparison (column 11, lines 10-11); generating another password that is different from the sent password (column 10, lines 43-59); storing the generated password in the nonvolatile memory of the second terminal (column 10, lines 59-61); sending the generated password to the network (column 9, lines 31-34); and storing the generated password in the storage (column 11, lines 24-29).



In reference to Claim 10, Yu discloses a communication terminal for communicating with a network including a nonvolatile memory (column 6, lines 15-26 and 35-46), a unit for generating a password (Figure 1, First Password Generator 123), and a unit for sending identification information and the password to the network and storing the password in the nonvolatile memory (column 9, lines 31-34; column 10, lines 59-61).

In reference to Claim 11, Yu further discloses that the password is generated at random (column 6, lines 47-60, where the password generation includes encrypting a random number).

In reference to Claim 12, Yu further discloses that the terminal includes a port for sending and receiving (Figure 1, Card Receiver 121; column 6, lines 40-46; also column 9, lines 31-34, where the password is sent from the terminal to the server).

In reference to Claim 13, Yu further discloses a removable storage medium (Figure 1, IC Card 100; column 6, lines 15-16).

In reference to Claim 14, Yu discloses a network apparatus for enabling communication between a terminal and the network including a storage (Figure 1, Memories 141 and 142) and a controller that receives identification information and a password from the terminal (column 10, lines 64-66), compares the received identification information and password to identification information and a password stored in the storage (column 11, lines 7-10), and stores a received password in the storage (column 11, lines 24-29).

Claims 15, 16, 17, 18, and 19 are directed to software implementations of the methods of Claims 1, 3, 6, 7, and 8, respectively, and are rejected by a similar rationale. Similarly, Claim 20 is directed to a computer program product implementing the terminal of Claim 10, and is rejected by a similar rationale. Further, Claim 21 is directed to a computer program product implementing the apparatus of Claim 14, and is rejected by a similar rationale.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- a. Yanagihara et al, US Patent 6567919, disclose an authentication procedure for computers on a network using randomly generated passwords that are only valid a limited number of times.
- b. Heinz, Sr., US Patent 5812764, disclose a password management system for a network that includes a list of randomly generated passwords, in which a new password is selected after a predetermined amount of time.
- c. Yu et al, UK Patent Application GB 2317983, disclose a user authentication system using one-time passwords. This is a member of the patent family of US Patent 6067621, cited above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (571) 272-3870, as of 26 October 2004. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2137